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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/788,661	02/26/2004	Christopher W. Blackburn	1842.021US1	3601
70648 7590 02/26/2010 SCHWEGMAN, LUNDBERG & WOESSNER/WMS GAMING P.O. BOX 2938 MINNEAPOLIS, MN 55402				
EXAMINER DEODHAR, OMKAR A				
ART UNIT		PAPER NUMBER		
3714				
NOTIFICATION DATE		DELIVERY MODE		
02/26/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

uspto@slwip.com  
request@slwip.com

# Office Action Summary

**Application No.**

10/788,661

**Applicant(s)**

BLACKBURN ET AL.

**Examiner**

OMKAR A. DEODHAR

**Art Unit**

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

In view of the Appeal Brief filed on 4/7/2009, PROSECUTION IS HEREBY REOPENED.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below.

***Response to Arguments***

Applicant's arguments have been considered but are moot in view of the new grounds of rejection. Specifically, Examiner while agrees that Gatto's mention of UDDI is insufficient to anticipate the claimed invention and Gatto's disclosure of authorizing service updates does not anticipate authorizing applications, after further search, prior art to Lagosanto (US 7,003,663) was discovered. Gatto in view of Lagosanto renders the claimed invention obvious because Lagosanto teaches validating information prior to forming and releasing a service bundle. This means that Gatto's discovery agent & software would validate or authenticate service information prior to its publication. See Lagosanto Col. 6. Lines 40-51.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 1-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gatto (US 6,916,247) in view of Lagosanto (US 7,003,663).**

**With respect to claims 1, 13, 25:** Gatto discloses a method, gaming network (abstract) & tangible medium (Col. 17. Lines 15-20) storing executable code for providing a gaming service in a gaming network (Col. 15. Lines 20-30), the method comprising: sending service information for the gaming management service from the gaming management service to a discovery agent on the gaming network, (See Col. 15 .Lines 54-56 teaching publication of web services, UDDI, and software searching for, and binding to said services) wherein the gaming management service provides configuration updates for a plurality of gaming machines communicably coupled to the gaming network, (See Fig 1 showing a number of machines coupled to a network.

See Fig 13 showing a number of gaming machine components receiving service updates as described in the cited portion of Col. 15.)

wherein in response to a wager at a gaming machine of the plurality of gaming machines the gaming machine depicts indicia representative of a randomly selected outcome of a wagering game; (See Col. 3. Lines 52-59 describing operation of a gaming machine.)

While Gatto discloses publishing availability of service on a gaming network (Figure 19: "Broadcast Availability" & Col. 13. Lines 64-67), utilizing a discovery agent, (Col. 15. Lines 49-56.), he does not teach the claimed sequence of:

Determining by the discovery agent if the gaming management service is authentic authorized; in response to determining that the gaming management service is authentic and authorized, publishing service information to a service repository to make the gaming management service available on the network.

This is interpreted as requiring service authorization as a prerequisite to service publication. In a related invention, Lagosanto teaches validating information prior to forming a service bundle that is to be published or released. See Lagosanto Col. 6. Lines 40-51.

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify Gatto with Lagosanto's teaching of validating information prior to forming a service bundle that is to be published or released. As described above, in Col. 15, Lines 54-56, Gatto teaches publication of web services, UDDI, and software searching for, and binding to said services. Gatto is thus amenable to being modified such that discovered applications or services are validated prior to being published or released. This yields the predictable results of precluding malicious code from being installed, let alone even published on

the network. Changes to the prior art utilizing known elements yielding predictable results are considered obvious.

Gatto further discloses receiving by the discovery agent a request for the location of the service from a gaming machine coupled to the network (Figures 19 & 20), where examiner notes that the steps “Broadcast Availability,” “Bind to Device” and “Communication” are interpreted as teaching this limitation. Gatto additionally discloses, returning the service information for the gaming management service to the gaming machine, sending a request to register the machine with the service, and determining if the machine is authorized (Gatto teaches registering the gaming machine with the service, (Fig. 20 & Col. 14. Lines 9-32), where it is noted that the server (112) registers (or subscribes) with specialized devices (gaming machines). The gaming machine would have to be authorized for this registration to be successful.)

and in response to determining that the machine is authorized to use the service, processing service requests between the gaming machine and the service, (Figure 19; Col. 15. Lines 45-49; Col. 15. Lines 57-60; Col. 16. Lines 7-11; Col. 18. Lines 4-6) to provide the configuration updates the gaming machine.

**With respect to claims 2, 14 and 26,** Gatto discloses that the game management service is a web service, (Col. 15. Lines 49-56.)

**With respect to claims 3-5, 15-17 and 27-29,** Gatto discloses that peripheral devices (gaming machines or video/entertainment/game engines located in the gaming machine) issue service requests (Col. 16. Lines 1-42.) Please note that a plurality of different service types is encompassed by the disclosure of Gatto. Configuration type updates include, for example, the “immediate code upgrade,” (Col. 16. Line 50.) Additionally, the featuring of downloading

configurations is inherent with respect to networked devices. This disclosure combined with the discussion of service requests, as presented with respect to claim 1, fully disclose the claimed limitations.

**With respect to claims 6, 18, 30,** Gatto discloses that service requestors discover available services and bind to the service providers accordingly, (Col. 15. Lines 57-67.) Additionally, Gatto discloses that peripheral devices (gaming machines) are service requestors, (Col. 16. Lines 5-10.) The process of discovering all available services and subsequently binding to service providers clearly involves status queries.

**With respect to claims 7-8, 19-20 and 31-32,** Gatto discloses that devices are configured to offer direct asynchronous notification of events to a central server over the communication network, (Col. 2. Lines 37-45 & Figure 20.) Additionally, Gatto discloses that the server may subscribe with the specialized devices (gaming machine) for the list of events that are of interest (interpreted as events matching certain criteria), (Col. 14. Lines 8-32.) Please also note the discussion of "callback," (Col. 14. Lines 8-32.)

**With respect to claims 9-11, 21-23 and 33-35,** please refer to the rejection of claims 1-7, above. Please also note that the claimed limitations of a configuration query (claim 9), status query, (claim 10), and device status, (claim 11) are query types inherent to the system because, at the least, the server is able to query every networked device to determine its status.

**With respect to claim 12, 24 and 36,** Gatto discloses a coin acceptor (Figure 2, Item 204) that may be coupled to the network platform (Col. 9. Lines 33-43.)

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 13 & 25 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 8, 13, 20 & 27 of copending Application No. 10/788,902. Although the conflicting claims are not identical, they are not patentably distinct from each other. Both inventions seek to patent a method of providing game service updates on a gaming network wherein service information is sent to a discovery agent, the discovery agent determines if the service is authentic and authorized and then publishes the service information. Whereas the present application processes service requests to update gaming machines, the copending application additionally requires processing service requests to provide game content. A person of ordinary skill in the art would realize that once update information is received by a networked gaming machine, the update could also reflect game content. As such, it

would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to provide game content updates along with gaming machine service updates.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OMKAR A. DEODHAR whose telephone number is (571)272-1647. The examiner can normally be reached on M-F: 8AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Omkar Deodhar/

/Peter D. Vo/  
Supervisory Patent Examiner, Art Unit 3714